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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,226	03/23/2004	Waichi Yamamura	007874-0308775	1771
441 7590 02/28/2007 SMITH, GAMBRELL & RUSSELL 1850 M STREET, N.W., SUITE 800 WASHINGTON, DC 20036			EXAMINER HOFFMANN, JOHN M	
			ART UNIT	PAPER NUMBER
			1731	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/28/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/806,226	Applicant(s) YAMAMURA ET AL.	
	Examiner John Hoffmann	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As indicated in **MPEP 2173.05(p) II**:

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

Such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

Claim 11 requires both apparatus and method steps. The claim requires that the furnace heats the base material, that the hanging mechanism supplies, and the elongating mechanism pulls the base material. Since the claim is directed to neither a process nor a machine, applicant cannot obtain a patent therefore.

Similarly, the following 112 rejection is made:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As pointed out above, hybrid type claims are indefinite. Alternatively: it is unclear what is meant by the limitations that furnace heats the base material, that the hanging mechanism supplies, and the elongating mechanism pulls the base material. It is unclear if they are merely intended use limitations.

It is noted that if the steps of "heats", "supplies", etc. are merely intended use limitations, it is unclear if the holding of the standard rod can also be interpreted as intended use. When one part of an apparatus "holds" some other part – that is typically considered to be a clear, definite structural limitation. But presently, if the other verbs signify intended use, it is unclear whether it is reasonable to conclude that the verb "holds" is some special verb that cannot be interpreted as an intended use.

At line, 4 of claim 11 "predetermined (straightness)" reads on a nebulous mental step conducted prior to the manipulative steps of the claimed process, hence rendering the present process claim unclear in meaning in scope. If applicant wishes to patent detail controls over the recited process, the the process steps must be positively recited. See Seagram & Sons Inc. vs Marzall, 84 USPQ 180.

From MPEP 2173.05(h):

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Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925).

Presently, claim 11 (last two lines) has a group which is very similar to the above accepted form, but there is no indication that the group is "consisting of" the members. Therefore it is impossible for anyone to tell if applicant's group is open or closed to additional members - and thus the claim presents uncertainty or ambiguity with respect to the question of scope of the claim. If the above "acceptable form" is not desirable for Applicant, Examiner can be telephoned for other expressions. It is unclear if the claim requires at least one of each of the mechanisms - or if it requires only one of them.

The term "parent" is indefinite as to its meaning. First, there is no explanation or definition regarding what is meant by this term. Second, from the disclosure it appears that base material is converted substantially entirely into the glass rod. Third, the plain meaning of "parent" suggests that there is an offspring which issues from the parent - that is: at least a substantial portion of the parent still remains. One would not be able to determine whether the claim requires an offspring-type creation, or if it also reads on complete conversion. A claim interpretation that puts the preferred embodiment outside the claim is "rarely, if ever, correct and would require a highly persuasive evidentiary support", Vitronics, at 1583. Also, the Office cannot disregard the term "parent" or any other term of the claims.

It is unclear what is meant by a "standard" rod. Clearly not any rod can be a standard rod - otherwise the term "standard" has no relevance. No part of a claim can

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be disregarded as irrelevant. One would not be reasonably capable of determining whether a particular rod is "standard" or not. One of ordinary skill should be permitted to be able to avoid infringement by using a similar apparatus which has a rod which is not a standard.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoshino 5674306.

Looking to figure 6: 23 and/or 10 is the furnace. 1 and/or 2 is the standard rod – it is deemed to be standard for whatever Hoshino qualified as being sufficient: i.e. it meets a sufficiency standard. 17 and/or 12 is the hanging mechanism. 18 and/or 13 is the elongating mechanism. As to the holding "to adjust": it is noted that holding and adjusting tend to require opposite things – non-movement and movement. It is deemed that Hoshino mechanisms hold to adjust in as much as applicant's does. For example, if the rod were crooked, device 18 would tend to align it when its holding was activated.

Claim 12: See col. 1, lines 31-48. The rod is made of glass. Glass is a ceramic.

Claim 13: see col. 1, lines 48-61.

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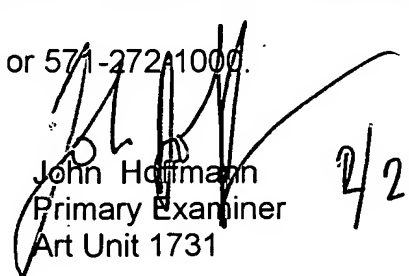
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Saito and Yamamura are cited as being cumulative to Hoshino.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


John Hoffmann
Primary Examiner
Art Unit 1731

2/27/2007

jmh